

Remarks/Arguments:

The pending claims are 1-16. Claims 1, 2, 8, 14, and 16 have been amended. No new matter is introduced therein.

Claim 2 has been rejected under 35 U.S.C. § 112, second paragraph because of the phrase "common function." Claim 2 has been amended by changing the phrase to "telephone function." This amendment is supported by page 7, line 6 of the specification which states that "the modem has a telephone function." Accordingly, applicant requests that the rejection be withdrawn.

Claims 1-2, 7-8 and 13-16 have been rejected under 35 U.S.C. § 102(e) as anticipated by Borella et al. (U.S. Patent No. 6,731,642). Paragraph (e) of amended claim 1 recites, in part:

said first modem. . .acquires an IP address corresponding to a telephone number of the second telephone set from the server, when the telephone number of the second telephone set is entered in the first telephone set, and then transmits a connection request to said second modem.

The Office Action contends that column 8, lines 16-45 discloses that the first modem acquires an IP address corresponding to a telephone number of the second telephone set from the server when the telephone number of the second telephone is entered in the first telephone set. Applicant respectfully disagrees.

The cited section of Borella follows the statement in Borella that the user of caller station 24 has entered the telephone number of the callee (destination) station. (col. 7, line 67-col. 8, line 3). The cited section, however does not disclose that the first modem (associated with the caller station) "acquires an IP address corresponding to a telephone number of the second telephone set (destination station) from the server." (emphasis added) Although this section of Borella describes many transmissions flowing to and from the caller side, none of the transmissions is "an IP address corresponding to a telephone number of the second telephone set" that the first modem (router 18) acquires from server 34.

- Router 18 receives a first address allocation message from gatekeeper (computer) 30. The first address allocation message has the public first gatekeeper address as its source address, the public first router address as its destination address, and includes the private caller address in its payload. (col. 8, lines 28-34) (emphasis added)
- First router 18 then allocates a proxy public caller address. (col. 8, lines 35-37). The proxy public caller address serves to identify caller station 24. (col. 8, lines 37-38) (emphasis added)
- First router 18 then transmits a first address response message to gatekeeper 30. The first address response message has the public first router address as its source address, the public first gatekeeper address as its destination address, and includes the proxy public caller address allocated by first router 18. (col. 8, lines 38-45) (emphasis added)

Accordingly, only information about the caller (first telephone set) is transmitted to first modem 18. There is no disclosure that the "first modem. . .acquires an IP address corresponding to a telephone number of the second telephone set from the server." (emphasis added) For this reason alone, amended claim 1 is not subject to rejection under 35 U.S.C. § 102(e) as anticipated by Borella et al.

In addition, amended claim 1 recites that after the first modem acquires the above-described information about the second telephone set, the first modem "transmits a connection request to said second modem." This feature is not shown in Borella et al. Borella connects the two telephone sets in a very different way. When the destination telephone 26 answers the call, second telephony interface 28 transmits a first originating connect message to second router/modem 20. Second router/modem 20 "then transmits a second originating connect message over intermediate network 12 to first router 18." At that point, first router/modem 18 transmits a connect message to first telephony interface 22. First router/modem 18 does not transmit a connection request to the second modem, as recited in amended claim 1. Instead, the connect message in Borella only "provides an indication. . .to caller station 24 that callee station 26 has answered the telephone call." (col. 10, lines 10-12).

Accordingly, for these additional reasons, amended claim 1 is not subject to rejection under 35 U.S.C. § 102(e) as anticipated by Borella et al. Since claims 2 and 7 depend from amended claim 1, they are also not subject to the same rejection.

Claim 8 has been amended in a manner that is similar to amended claim 1. Claim 8 now recites, in part:

said modem. . .acquires an IP address corresponding to a telephone number of a destination side from the server, when the telephone number of the destination side is entered in the telephone set, and then transmits a connection request to the destination side.

For the reasons explained above regarding amended claim 1, amended claim 8 is not subject to rejection under 35 U.S.C. § 102(e) as anticipated by Borella et al. Since claim 13 depends from amended claim 8, it is also not subject to the same rejection.

Claim 14 has been amended consistent with the amendments to claims 1 and 8. Claim 14 has been amended, in part, to recite:

- (c) acquiring in said caller the IP address in said server corresponding to said telephone number;
- (d) transmitting a connection request from said caller to a destination having said telephone number; and
- (e) establishing said call to said destination having said telephone number based on said IP address.

Original paragraph (c) (before claim 14 was amended) identified the telephone number recited in paragraph (a) as the destination telephone number. This feature in original paragraph (c) is now in new paragraph (e). Similar to paragraph (e) of amended claim 1, new paragraph (c) of amended claim 14 recites that the first modem acquires an IP address corresponding to the telephone number of the second telephone set. Instead of reciting a modem, however, new paragraph (c) in amended claim 14 recites that "said caller" acquires "the IP address in said server corresponding to said telephone number." As shown above, this step is not disclosed in Borella et al. Also similar to paragraph (e) of amended claim 1, new step (d) recites: the first modem transmits a connection request to said second modem. Instead of reciting a modem, new paragraph (d) recites that the connection request is transmitted "from said caller to a destination having said telephone number." As shown above, this step is not disclosed in Borella et al. After the connection is transmitted, step (e) recites that the call to the destination

is established. For all of these reasons, amended claim 14, and dependent claim 15, are not subject to rejection under 35 U.S.C. § 102(e) as anticipated by Borella et al.

Claim 16 has also been amended consistent with the amendments to claims 1 and 8. Claim 16 has been amended, in part, to recite:

a transmitter for transmitting to said caller one of said IP addresses corresponding to said one of said telephone numbers; and

an output port for transmitting a connection request from said caller to a destination and for attempting to establish connection with said destination having said one of said telephone numbers based on one of said IP addresses corresponding to said one of said telephone numbers.

For the reasons discussed above regarding amended claims 1, 8 and 14, amended claim 16 is not subject to rejection under 35 U.S.C. § 102(e) as anticipated by Borella et al.

Claims 3-5 and 9-11 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Thornton et al. (U.S. Patent No. 6,363,065). Claims 3-5 depend from amended claim 1. Claims 9-11 depend from amended claim 8. As discussed above, Borella does not disclose the inventions recited in amended claims 1 and 8. Thornton also does not disclose features in amended claims 1 and 8 that are missing from the Borella disclosure. Therefore, even if Borella and Thornton were combined, amended claims 1 and 8 would not be subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Thornton. Accordingly, dependent claims 3-5 and 9-11 are also not be subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Thornton.

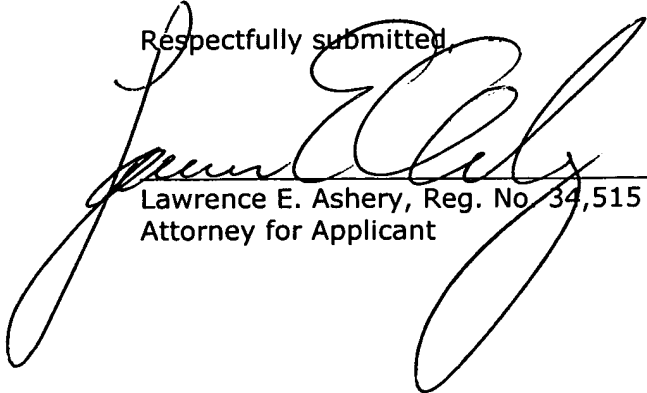
Claims 6 and 12 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Moon (U.S. Patent No. 5,864,758). Claim 6 depends from amended claim 1. Claim 12 depends from amended claim 8. Moon does not disclose features in amended claims 1 and 8 that are missing from the Borella disclosure. Therefore, even if Borella and Moon were combined, amended claims 1 and 8 would not be subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Moon. Accordingly, dependent claims 6 and 12 are also not be subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Moon.

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For all of the above reasons, applicant solicits allowance of the entire application.

Respectfully submitted,


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